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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/000,924	12/30/97	HASEBE	T 1083.1048/JD

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LMC1/0803

EXAMINER

NGUYEN, C

ART UNIT	PAPER NUMBER
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2764

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DATE MAILED: 08/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/000,924

Applicant(s)
Hasebe et al.

Examiner
Cuong H. Nguyen

Group Art Unit
2764



☒ Responsive to communication(s) filed on Jul 13, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-22 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

1. This Office Action is the answer to the Request for CPA & 1 month extension received on 7/14/2000, which paper has been placed of record in the file.
2. Claims 1-22 are pending in this application.
3. The following rejections are based on the examiner's broadest reasonable interpretation of the claims; In re Pearson, 181 USPQ 641 (CCPA 1974).

Claim Rejections - 35 USC § 103

4. Claims 1-5, 9, 12, 15, 18-22 are rejected under 35 U.S.C. § 103 as being unpatentable over Hasebe et al. (US Pat. 5,392,351), in view of Hasebe et al. (US Pat. 5,761,651), further in view of Iwayama et al. (US Pat. 5,832,083).

A. Referring to claim 22: The claim is directed to a data protection system, comprising:

- means for storing data (this limitation is in claims 4, 9, 15, and they are very obvious with cited prior arts; see at least Hasebe et al. '351 claim 8);
- storage means for storing data (this limitation is in claims 1, 4, 9; see at least Hasebe et al. '651 Figs. 1, 5 ref.303);

- working/preparing means with input data (this limitation is in claims 1, 4, 9, 12, 15, it comprises a different/broad term for actions comprising: preparing, generating, appending, displaying data .etc., and they are very obvious with cited prior arts, see at least Hasebe et al. '351 3:47-56);

- means for generating information relating to input data (which is to be utilized in prepared data) (e.g. judging means, this limitation is in claims 1, 9, 12; see at least Hasebe et al. '651 6:8-17, 50-65; see also Iwayama et al. '083 Fig.10 (refs. 1009, 1010), Fig.16 (refs. 1607, 1608), & Figs. 18-19);

- comparing/judging means if using input data (this limitation is in claims 1, 4, 9 - see Hasebe et al. '651 6:8-17, 50-65, Figs. 8-9; see also Iwayama et al. '083 Figs. 4 (ref. 2), 7, 8(ref.2a), 13-14, 16);

- means for updating/appending/adding generated information to prepared data (this limitation is in claims 1, 12) (see at least Hasebe et al. '651 claim 12 for obviousness);

- means for displaying (prepared)/input data (this limitation is in claims 1, 12); (see at least Hasebe et al. '083 Figs.4(ref.5), 5; Fig.20 (refs.2014, 2016); see also Hasebe et al. '651 Fig.2 for obviousness); and

Hasebe et al. do not specifically teach about means for forbidding saving (input) data. (this limitation is in claims 1, 4, 9).

However, the examiner submits that this limitation is well-known in the art; e.g. a decision-making query/instruction for a similar task ("not saving data if ...): because it is simply an optional query/instruction that it would be recognized as useful to put in a computerized system. The examiner submits that although this claim is written with a different structure from original claim 1, one of ordinary skills in the art at the time of the invention would have found claim's limitations very obvious with inherent steps as suggested by cited prior art; prior art's limitations are not necessary spelled-out exactly claimed languages (see previous Office Action). Cited prior arts are not limited to the described embodiments in these inventions. It is reasonable that various modifications and variations of the described method and system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although these inventions have been described in connection with specific preferred embodiments, it should be understood that those invention as

claimed should not be unduly limited to such specific embodiments.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to suggest a system for combining the teaching references to apply above limitation in the disclosure of Hasebe et al., because this would increase extra flexible options for a data protection system.

B. Referring to claims 4, 9, 12, 15, 18-21: The limitations of these claims recite similar claims' limitations (of fewer limitations) as claim 1 discussed above. The same analysis and reasoning set forth above in the rejection of claim 1 applied to these claims also because they cover a similar method/system/device that doing same steps with similar means.

C. Referring to claim 2: Claim 2 is directed to a data protection system, further comprising:

means for executing cut & paste; and
means for forbidding cut & paste (data).

The rationales for rejection of claim 1 are incorporated.

The examiner submits that these 2 limitations are very obvious & well-known because they would present a well-known feature (as options) to one with skills in the art.

D. Per claims 3, 5:

The rationales for rejection of claim 1 are incorporated.

D1. Referring to claim 3: This claim is directed to a data protection system with means for judging (input) data is encrypted data; and means for determining allowed/permitted data (see also Hasebe et al. '651 3:46-54 for obviousness).

The examiner submits that limitations for this claim are already discussed in claim 1 above. The rationales for rejection are similar.

D2. Referring to claim 5: The limitations of this claim recite the same claim's limitations (of fewer limitations) as claim 3 discussed above. The same analysis and reasoning set forth above in the rejection of claim 3 applied to these claims also because it covers similar limitations as the above system.

E. Referring to claim 6: This claim is dependent of claim 4, a limitation is a difference between original data to be worked and the data after. The rationales for rejection of claim 4 are incorporated. This limitation is obvious since it is an option to distinguish between old and new data with comparison means; see also Hasebe et al. '651 5:32-35 for obviousness).

F. Referring to claim 7: It is directed to a data protection system, comprising:

means for displaying (original) data, and updated data.

The rationales for rejection of this claim is similar as in claim 1.

5. Claims 10-11 are directed to a data protection system, comprising limitations that rationales for rejection of claims 1/9 are incorporated:

A. Re. Claim 10: A limitation is means for distributing data. Hasebe et al. obviously suggest this limitation (see at least Hasebe et al. '083 Figs. 14, 19 (ref.1910), and 20 (ref. 2014)).

B. Re. Claim 11: A limitation is means for distributing (update) data; Hasebe et al. obviously suggest this limitation (see at least Hasebe et al. '083 Fig. 21).

6. Referring to claim 8: The limitation in this claim is quite obvious with one of skills in the art to add an option as storage means includes means for adding information; Hasebe et al. obviously suggest this limitation. (The rationales for rejection of claims 1 are incorporated; then see at least Hasebe et al. '651 claim 12).

7. Referring to claims 13, 16:

A. Per claim 13: The limitations in these claim are quite obvious with one of skills in the art:

judging (yes or no) (there is a license for utilizing data. (same claim's limitation as #1.f, and #9) ; and

means for permitting/allowing input data to be displayed.
(same claim's limitation as in claim #1).

The same rationales for rejection of claims 1 are used herein.

B. Referring to claim 16:

The limitations of this claim recite the same claim limitations as claim 13 above. The same analysis and reasoning set forth in the rejection of claim 13 applied to this claim also because it covers a device that having similar means.

8. Referring to claim 14: The limitation in this claim (#14) is obvious and well-known with one of skills in the art: The data preparation device/protection system wherein the balance of the charge is used as the license (because it is still less than a maximum balance available; with rationales for rejections of claims 1 are incorporated).

9. Referring to claim 17: The limitation of this claim recite the same claim's limitation as claim 14 discussed above. The same analysis and reasoning set forth above in the rejection of claim 14 applied to this claim also because it covers a device that including similar means.

Conclusion

10. Claims 1-22 are rejected.

11. Remarks: Since the CPA includes some arguments that are relating to obviousness judgement from the examiner, several court decisions are listed as the basis for the examiner decisions. Moreover, "input data" and "data", "embedding data" are not distinguishable for claims 1-2's languages (you can't perform any operation on "embedded" data (e.g. cut & paste functions within an embedded data), it must be operated as "a whole"; therefore, the examiner assumes a broader interpretation of these terms in examination (i.e. input data).

A. About carrying forward another's invention--Design choice to make integral (e.g. "Embedded data" in claims 1, 22):

B. In re **Larson**, 144 USPQ 347 (CCPA 1965) the court said:

"While the brake disc and clamp of Tuttle et al. comprise several parts, they are rigidly secured together as a single unit. The constituent parts are so combined as to constitute a unitary whole. Webster's New International Dictionary (2nd edition) defines "integral" as "(2) composed of constituent parts making a whole; composite; integrated." We are inclined to agree with the board's construction of the term "integral" as used in claim 12. Then, too, we are inclined to agree with the position of the solicitor that the use of a one piece construction instead of the structure disclosed in Tuttle et al. would be merely a matter of

obvious engineering choice. In re Fridolph, 50 CCPA 745, 89 F.2d 509, 135 USPQ 319.

C. And In re Lockhart, 90 USPQ 214 (CCPA 1951) the court said:

After a careful examination of the record, we do not find ourselves in agreement with appellant's argument. Although it is true that invention may be present under some circumstances in making integral that which was separate before, we do not feel that such is the case here. Improved results only will not take the case out of the general rule. There is also a requirement that the unification or integration involve more than mere mechanical skill. In re Murray, 19 CCPA 739, 53 F.2d 541, 11 USPQ 155; In re Zabel et al., 38 CCPA 832, 186 F.2d 735, 88 USPQ 367. In this case, all of the essential elements of the appealed claims except integration of parts, are found in the references. It appears to us that the unity or diversity of parts would depend more upon the choice of the manufacturer, and the convenience and availability of the machines and tools necessary to construct the syringe, than on any inventive concept.

D. In Howard v. Detroit Stove Works, 150 US 164 (CCPA 1893) the court said: "As to the 3rd patent, it is void because the claims in it were clearly anticipated, and because it involves no invention to cast in one piece an article which has formerly been

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cast in two pieces and put together, nor to make the shape of the grate correspond with that of the firepot".

E. In re Sheckler, 168 USPO 716 (CCPA 1971) the court said:

It is not necessary that a reference actually suggest changes or possible improvements which applicant made.

F. In re Bozek, 163 USPO 545 (CCPA 1969) the court said:

"Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'"

G. In re Gershon, Goldberg, and Neiditch, 152 USPO 602 (CCPA 1967) the court said:

"Although references do not disclose or suggest the existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103 since references suggest a solution to problem; it is sufficient that references suggest doing what applicants did, although they do not teach or suggest exactly why this should be done, other than to obtain the expected superior beneficial results."

H. In re Beattie, 24 USPO2d 1040 (CA FC 1992) the court said:

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"Board of Patent Appeals and Interferences correctly held that it would be obvious to one having ordinary skill in art to combine prior art references in order to arrive at claimed marking system for reading and playing music on keyboard or stringed instruments, despite absence of single express teaching of marking system which combines two musical theories of prior art references, since law of obviousness does not require that references be combined for reasons contemplated by inventor, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole".

I. Merck & Co. Inc. v. Biocraft Laboratories Inc., 10 USPQ2d 1843

(CA FC 1989) the court's opinion:

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments.

J. In re Heck, 216 USPO 1038 (CA FC 1983) the court 's opinion:

Similarly relative terms in claims are given broadest reasonable interpretation during patent application's prosecution.

K. In re Merck & Co., Inc., 231 USPO 375 (CA FC 1986) the court said:

"Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references."

L. In re Nievelt, 179 USPO 224 (CCPA 1973) the court said:

"Combining teachings of references does not involve an ability to combine their specific structures."

M. In re Bozek, 163 USPO 545 (CCPA 1969) the court said:

"Test for obviousness is not whether features of one reference may be bodily incorporated into the other to produce claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art."

N. In re Keller, Terry, and Davies, 208 USPO 871 (CCPA 1981) the court said:

"It is not necessary that device shown in one reference can be physically inserted into device shown in other reference to justify combining their teachings in support of rejection.", and

"Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

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O. In re Oetiker, 24 USPO2d 1443, 1445 (Fed. Cir. 1992) the court's opinion:

A prior art reference is analogous if the reference is in the field of applicant's endeavor or, if not, the reference is reasonably pertinent to the particular problem with which the inventor was concerned.

P. Lamont v. Berquer, 7 USPO2d 1580 (BdPatApp&Int 1988) the court said:

"Section 103 requires us to presume that the artisan has full knowledge of the prior art in his field of endeavor and the ability to select and utilize knowledge from analogous arts".

Q. In the amendment (received on 6/14/2000) applicants repeatedly argue that the cited references do not disclose the same concept of a data protection system that using against unauthorized use during utilization of the data; the examiner submits that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ 2d 1057 (Fed. Cir. 1993).

R. About preamble and statements of intended use (the applicants broader the claim by not specify a field of application in certain independent claims): An intended use

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clause found in the preamble of an apparatus claim is not afforded the effect of a distinguishing limitation unless the body of the claim sets forth structure which refers back to, is defined by, or otherwise draws life and breadth from the preamble. See In re **Casey**, 152 USPQ 235 (CCPA 1967); **Kropa v. Robie**, 88 USPQ 478 (CCPA 1951). Thus, a preamble is defined the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. See **Kropa v. Robie**, supra at 480. See also Ex parte **Mott**, 190 USPQ 311, 313 (PTO Bd. Of App. 1975).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can normally be reached on Monday-Friday from 7:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)305-9768.

Any response to this action should be mailed to:

Box Issue Fee

Amendments

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Commissioner of Patents and Trademarks
c/o Technology Center 2700
Washington, D.C. 20231

or faxed to:

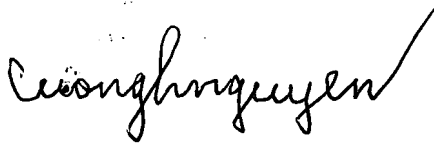
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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of
this application should be directed to the Group receptionist
whose telephone number is (703) 305-3900.



Cuong H. Nguyen
July 24, 2000